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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,164	09/08/2003	Juergen Schubert	237228US0	1323
22850 7590 04/18/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PARVINI, PEGAH	
			ART UNIT 1755	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			NOTIFICATION DATE	
3 MONTHS			04/18/2007	
			DELIVERY MODE ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/18/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/656,164	<b>Applicant(s)</b> SCHUBERT ET AL.	
	<b>Examiner</b> Pegah Parvini	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The rejection of claims 1-4, and 13-16 under 35 U.S.C § 102 (b) as being anticipated by CA 2255456 (cited from Canadian Patent Office) to Siray et al. and the rejection of claims 5-12, and 17-24 under 35 U.S.C § 103(a) by as being unpatentable over US Patent No. 5,034,207 to Kerner et al. in view of CA 2255456 to Siray et al. as generally set forth in the office action mailed on September 7, 2006 stand.
2. Regarding the newly submitted claims 25-26, Siray et al. disclose a precipitated silica and a wax emulsion with d50 values which are within the claimed ranges in the above claims; as disclosed in Table 3, the d50 values are 6.26 to 9.28 (page 12). Furthermore, Siray et al. disclose a precipitated silica which has a BET from 351-600 m<sup>2</sup>/g, DBP index values from 300-360, density from 70-140 g/l, size distribution index values of less than 1.0 (detailed description, pages 3-4; Claim 3).

The text of those sections of Title 35 US Code not included in this action can be found in prior Office Action.

### ***Response to Amendment***

3. Applicants' amendment to the Specification, regarding the EP application number and the reference to Example 1, in page 2, filed on February 2, 2007 is acknowledged.

As such, the objection to the specification set forth in the First Office Action is withdrawn.

4. Applicants' amendment to the Abstract in page 14, filed on February 2, 2007 is acknowledged.

However, as indicated in the First Office Action, the abstract was an incomplete sentence and was not descriptive. The amendment made to the Abstract has made it even shorter and it is still an incomplete sentence and a fragment. The amendment does not overcome the objection; therefore, the objection to the abstract stands.

#### ***Response to Arguments***

5. Applicants' arguments in pages 9-12, filed on February 2, 2007 have been fully considered but they are not persuasive. Therefore, the grounds of rejection for claims 1-24 as indicated in the first Office Action stand.

The examiner respectfully submits regarding the density, there is still overlap in the upper limit of the claimed range, the value of 70g/l, between the cited reference and the claimed application; in addition, the DBP index disclosed by the reference still has overlaps with the claimed range of the instant application (Siray et al.: detailed description titled Precipitated Silica, pages 2-3; Claim 1). The amended claim claims the DBP number as 350-400 g/100g; Siray et al. disclose DBP values as 300-360 g/100g. The d50 values are disclosed in Table 3 (Siray et al.: detailed description, page 12); as disclosed, the d50 values are within the claimed range in the amended claims as well as the newly submitted claims of 25 and 26. Siray et al., also, disclose a wax

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emulsion having the characteristics mentioned above (Siray et al. detailed description, page 4; Claim 3). It is noted that Siray et al. discloses the process of making the precipitated silica via milling and classifying in the detailed description section, and it's the same process through which the results of Table 3 was obtained. In general, Siray et al. disclose a precipitated silica and a wax emulsion, having the following characteristics: 351-600 m<sup>2</sup>/g of BET, 300-360 of DBP index, 70-140 g/l of density and I<1.0 which according to Table 3 has values for d50 which are in the claimed ranges.

6. Applicants' argument in page 10, filed on February 2, 2007 regarding Kerner reference has been fully considered but it is not persuasive. Therefore, the grounds of rejection for claims 6-12, and 17-24 as indicated in the first Office Action stand.

The examiner respectfully submit that the first Office Action indicates that Kerner is silent to the "use" of the claimed silica material; Kerner was used in a 35 USC § 103(a) rejection in conjunction with Siray et al. to reject the use of the claimed precipitated silica in paints.

7. Applicants' arguments in pages 1-3, filed on February 2, 2007 regarding the submission of the Declaration have been fully considered but they are not found persuasive. Therefore, the submitted Declaration was not considered.

The examiner respectfully submits that no table was found attached to the Declaration.

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The Declaration under 37 CFR 1.132 filed February 2, 2007 is insufficient to overcome the rejection of claims 1-24 or any of the claims based upon 35 USC § 102(b) and § 103(a) in view of Siray et al. and Kerner as set forth in the last Office action because: The Declaration did not contain any table; in fact, the Declaration lacked tested results for, at least, quite a few data points to indicate that Siray et al. could not disclose a precipitated silica having the density, DBP, and other disclosed characteristics as claimed in the instant application.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pegah Parvini whose telephone number is 571-272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PP

  
**J.A. LORENGO**  
**SUPERVISORY PATENT EXAMINER**